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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,109	12/09/2005	Harlan A. Hurwitz	115572.05	4395

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EXAMINER

KIM, STEVEN S

ART UNIT	PAPER NUMBER
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3685

MAIL DATE	DELIVERY MODE
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11/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,109

Applicant(s)

HURWITZ ET AL.

Examiner

STEVEN KIM

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the amendment filed on October 21, 2008 on Application No. 10/524,109, which was filed on December 10, 2005.

Status of claims

2. Claims 1-9, 10-20 are pending.
3. Claims 1, 4-6, 8, 12, 14, 16-18 and 20 have been amended.
4. Claims 10 and 21-33 have been cancelled.

Claim Objections

5. Claim 1 is objected to because of the following informalities: There is conjunction **and** missing between the recited two steps of causing and outputting. Appropriate correction is required.

Response to Amendments/Arguments

6. Applicant's has amended the claims on amendment filed October 21, 2008 and alleges the prior art does not disclose the newly added language. However, the Examiner respectfully disagrees.

7. In regards to § 102 rejections on claim 1-9 and 10-20, the Applicant alleges that “none of the paragraphs cited in Drummond prompt the responsible party whether it wants to receive the set of instructions” (see page 8 of the Applicant’s argument). The Applicant’s further believes the claims are allowable since the cited paragraphs lacks disclosure of instructions relating to prompt. However, instruction is a non-functional descriptive material and does not limit the steps of prompting a user. Drummond discloses cash dispensing automated banking machine and method, i.e. ATM (see ¶0002 and Title). Drummond further discloses prompting feature (¶0097, ¶0116, ¶0145, prompting user through operation of a transaction using the automated banking machine). The content of message, e.g. whether it wants to receive the set of instructions, in the prompt is non-functional descriptive material that does not affect the step of **prompting** nor affect any other recited steps in the claims. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP ‘ 2106. Thus, the prior art continues to read on the claims.

8. In further reference to claims 1-9, 11 and 20, the newly amended language renders the claims 1-9, 11 and 20 to be indefinite under 35 U.S.C. 112, second paragraph. It is unclear as to whether recited language [claim 1] of **informs ...**, **provides ... and prompts ...** is describing the communication or describing the intended use of the output device. An essential purpose of patent examination is to

fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed-In re Zletz,13 USPQ2d 1320 (Fed. Cir. 1989).

9. In regards to claim 20, the claim is directed toward a system, i.e. an output device and a controller coupled to the output device: for determining ..., for informing ..., for providing ... and for prompting. It is unclear which of the recited parts of the system, i.e. output device and controller, is for determining, for informing and for providing.

10. Claims 1-9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step is providing step in claim 1.

11. Claims 2-9 and 11 are rejected since each depends on claim 1.

12. In view of foregoing, the Examiner maintains the rejections on claims 1-9 and 11-20.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1-9, 11 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. In regards to claim 1, it is unclear as to whether recited language of **informs ...**, **provides ... and prompts ...** is describing the outputting a communication or describing the functions of output device. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed-In re Zletz,13 USPQ2d 1320 (Fed. Cir. 1989).

16. Claims 2-9 and 11 are rejected similarly as each depends on claim 1.

17. In regards to claim 20, the claim is directed toward a system, i.e. an output device and a controller coupled to the output device: for determining ..., for informing ..., for providing ... and for prompting. It is unclear which of the recited parts of the system, i.e. output device and controller, is for determining, for informing and for providing.

18. Claims 1-9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step is providing step in claim 1.

19. Claims 2-9 and 11 are rejected since each depends on claim 1.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 1-9 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond et al., US Patent Application No. 2005/0096994, hereinafter referred to as "Drummond".

22. In regards to claims 1, 10 and 20, Drummond discloses a method and system comprising:

- causing a controller to determine that a payment media handling operation event has occurred during the operation of the payment media handling apparatus (see ¶0148-¶0150; Fig. 1; Fig. 2);
- outputting a communication on an output device that:
 - informs a responsible party of the payment media handling operation event (see ¶0148-0153); and
 - provides a set of instructions comprising at least an audio and visual message to the responsible party on action steps to resolve the payment media handling operation events (see ¶0148-¶0153); and

- prompts the responsible party via the output device (see ¶0097; ¶0116; ¶0145; ¶0153), prior to the providing step, whether it wants to receive the set of instructions.

23. Furthermore, "whether it wants to receive the set of instruction" is non-functional descriptive material.

24. In regards to claims 2, 4-7 and 15-18, Drummond further discloses wherein the payment media handling operation event comprises at least one of a payment media handling apparatus error, a payment media handling apparatus electronic coupling event, a payment media handling apparatus operation question and a payment media processing event (claim 2) (see ¶0148; ¶0154);

- (claims 4 and 16) wherein the payment media handling operation event is a payment media handling apparatus error, and the payment media handling apparatus error comprises at least one of a payment media note jam, a payment media coin jam, a payment media note misfeed, a payment media coin misfeed, a payment media note double feed, an unauthorized payment media activity and a fraudulent payment (see ¶0148; ¶0154);
- (claims 5 and 17) wherein the payment media handling operation event is a payment media handling apparatus electronic coupling event, and the payment media handling apparatus electronic coupling event comprises an event which identifies that the payment media handling apparatus is coupled

to another electronic device (see ¶0148 - ¶0154; Fig. 2; ¶0053-¶0057; ¶0137); and

- (claims 6 and 18) wherein the payment media handling operation event is a payment media processing event, and the payment media processing event comprises one or more events associated with performance of a payment media operation (see ¶0148-¶0154, fault and status are part of performance of a payment media operation);
- (claim 7) wherein the payment media operation includes at least one of a payment media acceptance operation, a start fund operation, a payment media change dispensing operation, a payment media advance operation and a payment media bank deposit operation (see Fig. 2, Cash Dispenser 42; claim 12, level of currency; claim 10; ¶0148).

25. In regards to claims 3 and 13, Drummond also teaches wherein the set of instructions further comprises one or more of a visual message, an audio message and a text message (see ¶0151).

26. In regards to claim 8 and 14, Drummond further teaches wherein the responsible party includes at least one of a payment media handling apparatus user, a supervisory entity in the retail store, a supervisory entity not physically located in the retail store, a payment media handling apparatus repair representative, a security representative and a law enforcement official (see ¶0151, technician; ¶0034; ¶0153-¶0154; Fig. 1).

27. In regards to claims 9 and 19, Drummond also discloses wherein the audio and visual message comprises at least one of a computer slide presentation and a video presentation (see ¶0101, use of HTML document to present video and sound and ¶0151).

28. In regards to claim 11, Drummond further discloses wherein the step of determining that the payment media handling operation event has occurred comprises performing at least one of a payment media handling apparatus self-diagnostic action and a payment media handling apparatus self-correcting action (see ¶0151 - ¶0154; ¶0163).

Conclusion

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

30. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./

Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685